

REMARKS

No claims are amended, canceled, or added with this response; as a result, claims 1-35 are now pending in this application.

Petition to Make Application Special and Preliminary Amendment

Applicants note that a "Petition to Make Special" and a "Statement in Support of Petition to Make Special under 37 C.F.R. §1.102(d)" were filed in the application on August 21, 2006. In addition, a Supplementary Preliminary Amendment, which included amendments to claims 10 and 19, was also filed in the application on August 21, 2006. These documents are attached in the Appendix of this response for the Examiner's convenience and review, along with a copy of the date-stamped return postcard indicating that it was received by the U.S. Patent Office.

The Final Office Action incorrectly indicates that Applicants' Petition to Make Special was dismissed in the Decision On Petition mailed September 7, 2006. The Decision mailed September 7, 2006 denied the prior counsel's petition to withdrawal as attorney or agent of record as moot.

Applicants' representatives have not yet received a decision regarding the Petition to Make Special in this application. On Jan. 25, 2008 Applicants' representative Attorney Robert Madden contacted the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, (specifically, Pinchus Laufer at telephone number 571-272-7726) regarding the Petition to Make Special filed in the application, and was informed that a review of the status of the Petition to Make Special and a response would be forthcoming.

Applicants further respectfully request an acknowledgement of receipt of the Supplementary Preliminary Amendment filed August 21, 2006, and confirmation that the amendments to the specification and to the claims as provided in the Supplementary Preliminary Amendment have been entered in the application.

§103 Rejection of the Claims

Claims 1-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Esposito et al. (U.S. 6,587,838, hereinafter "Esposito"). Applicants respectfully traverse the rejection of claims 1-35.

Applicants maintain each of their arguments presented in Applicants' previous response filed in the application¹ stating that the previous Office Action² failed to meet its burden for establishing a *prima facie* case of obviousness with respect to the rejection of claims 1-35. The previous Office Action, and now the Final Office Action, both fail to meet their required burden for establishing a *prima facie* case of obviousness with respect to claims 1-35.

As with the previous Office Action, the Final Office Action fails to point out in Esposito, or in any other evidence of record, a disclosure or suggestion of all elements of the claimed subject matter included in claims 1-35. By way of illustration, independent claim 1 includes:

"A method to facilitate a transaction by a network-based transaction facility, the method including:

receiving a request from a buyer accessing the network-based transaction facility to view offerings that are offered for sale via the network-based transaction facility;

responsive to the request, **retrieving information concerning a plurality of offerings, wherein the plurality of offerings include a first offering of a first transaction type and a second offering of a second transaction type;**

integrating information concerning the first and second offerings into a commingled list; and

causing the display of the commingled list to the buyer."

(Emphasis added).

Thus, independent claim 1 includes, "retrieving information concerning a plurality of offerings . . . including a first offering of a first transaction type and a second offering of a second transaction type." The Final Office Action fails to point out a disclosure or suggestion in Esposito of this subject matter, as included in independent claim 1.

¹ See Applicants' response mailed August 9, 2007 in the application in response to the non-Final Office Action mailed April 9, 2007 in the application.

² Referring to the non-final Office Action mailed April 9, 2007 in the application.

In contrast to independent claim 1, Esposito concerns "providing *real-time notification to vendors* of purchaser requirements in a heterogeneous network environment,"³ wherein, "Users interact with plurality of client computers 102 in order to view information about products stored in product database 120."⁴ (Emphasis added). However, there is no disclosure or suggestion in Esposito, and the Final Office Action fails to provide any other evidence of record, disclosing or suggesting, "retrieving information concerning a plurality of offerings, wherein the plurality of offerings include a first offering of a first transaction type and a second offering of a second transaction type," as required by independent claim 1.

Further, Applicants maintain that Esposito fails to disclose or suggest, and actually teaches away from, "integrating information concerning the first and second offerings into a commingled list, and causing the display of the commingled list to the buyer," as included in independent claim 1. According to Esposito:⁵

"In a step 410, a user at one of the plurality of client computers is presented with a plurality of product options and services from which to make a selection. Then, in a step 412, responsive to user input indicating a particular product from a menu, the user is provided product information, including photographs, retrieved from the product database 120. In a step 414, a product selection and user specific information, including geographic information, is received from the user. In a step 416, a purchase request is transmitted to the vendor computer over the public packet switched communications network. Then, in a step 418, the purchase request is analyzed by the vendor computer to determine the product and proximity information of the user. Incoming information is examined to determine proximity information such as the area code or postal code of the user. This information determines which wireless service provider region and terminal accounts can be selected to receive vendor notification. In a step 420, based upon the proximity information, a plurality of vendors is selected from the product database 120, each of the vendors being in close proximity to the user. In a step 422, a wireless region and account information associated with each of the plurality of selected vendors is determined. Next, in a step 424, information about the user is recorded in the customer database

³ See Esposito at column 1, line 32-34.

⁴ See Esposito at column 3, lines 28-30.

⁵ See Esposito at column 4, line 55 through column 5, line 15.

122. In a step 426, **vendor notification message 50 is transmitted to each of the selected vendors via the wireless network 108, based upon the wireless region and account information.**" (Emphasis added).

Thus, the description of the Esposito system is concerned with transmitting *to vendor computers* the product selections of a user. This fails to disclose or suggest, and actually teaches away from, the above quoted subject matter from independent claim 1 in which the commingled list is displayed *to the buyer*. The purpose of the vendor notification of Esposito, according to the description in Esposito, is to see "if any of the one or more vendors can complete a purchase and sale transaction with the user, the vendor can contact the user directly."⁶ The Esposito description teaches away from the subject matter of independent claim 1, wherein independent claim 1 includes, "integrating information concerning the first and second offerings into a commingled list; and causing the **display of the commingled list to the buyer.**" (Emphasis added).

The Final Office Action points to no disclosure or suggestion in Esposito, or in any other evidence of record, showing where the above highlighted text elements of independent claim 1 are disclosed or suggested.

Instead, the Final Office Action merely states, without providing any evidence of record to support these statements, the following argument:⁷

"It would be obvious to an ordinary practitioner of the art at the time of Applicant's invention that Esposito's disclosure includes the facilitating of a transaction by a network-based transaction facility, the method including: to view offerings that are offered for sale via the network-based transaction facility; responsive to the request, retrieving information concerning a plurality of offerings, wherein the plurality of offerings include a first offering of a first transaction type and a second offering of a second transaction type; integrating information concerning the first and second offerings into a commingled list; and causing the display of the commingled list to the buyer." (Emphasis in original).

⁶ See Esposito at column 3, lines 44-46.

⁷ See the Final Office Action at page 2 under item number 2.

In an attempt to support these statements, the Final Office Action refers to Esposito as teaching:⁸

"A plurality of client computers are part of the system. The client computers enable users to interact with the system to learn about and express interest in products and services, (Abstract, II. 10-16) Further, Esposito teaches "Each of the client computers is able to present to a user a plurality of product options and services from which the user can make a selection. Responsive to the users' input indicting a particular product from a menu, the client computer provides product information such as pictures, retrieved from the product database by the vendor computer over the public packet switch network"(Col. 2, II. 13-16). Therefore, Esposito teaches or suggests 'integrating information concerning the first and second offerings into a commingled list, and causing the display of the commingled list to the buyer'."

While Applicants do not necessarily agree with these statements, even if true, the statements still fail to disclose or suggest the subject matter as quoted above from independent claim 1. As noted above, independent claim 1 includes "retrieving information concerning a plurality of offerings, wherein the plurality of offerings *include a first offering of a first transaction type and a second offering of a second transaction type.*" (Emphasis added). Therefore, any disclosure or suggestion in Esposito of integrating information concerning a first and second offerings into a commingled list, (wherein Applicants do not agree or admit that there is any such disclosure or suggestion in Esposito) still fails to disclose or suggest a first offering of *a first transaction type* and a second offering of *a second transaction type*, as included in independent claim 1.

Since there is no disclosure or suggestion of the first offering of a first transaction type and a of a second offering of a second transaction type in Esposito, there cannot be a disclosure or suggestion in Esposito of "integrating information concerning the first and second offerings into a commingled list; and causing the display of the commingled list to the buyer," all as required by independent claim 1.

⁸ See the Final Office Action at page 8, lines 1-11.

Thus, the Final Office Action fails to point out where there is any disclosure or suggestion in Esposito of at least this subject matter as included in independent claim 1, and so appears to be taking Official Notice of this subject matter included in independent claim 1 and missing from Esposito. Applicants traverse any such taking of Official Notice with respect to independent claim 1, and for analogous reasons, traverse the taking of Office Notice with respect to independent claims 18 and 35.

Further, Applicants traverse the Final Office Action's admitted taking of Official Notice with respect to dependent claims 2-17 and 19-24.⁹ For example, the Final Office Action expressly takes Official Notice of the subject matter of claims 2-17 and 19-34 by stating "... the examiner takes official notice that it was well known at the time of Applicant's invention wherein:." The Final Office Action then proceeds to itemize over 16 separate statements regarding subject matter of claims 2-17 and 19-34 that the Office Action asserts, "... would have been obvious to an ordinary practitioner of the area at the time of Applicant's invention ...".¹⁰

Contrary to the Examiner's practice here, according to the MPEP, when the Examiner is relying on common knowledge in the art or "well known" prior art, the following requirements apply to the Examiner taking "Official Notice":¹¹

In *>certain< circumstances >where appropriate<, ** an examiner *>may< take official notice of facts not in the record or * rely on "common knowledge" in making a rejection, however such rejections should be judiciously applied.

Further, the MPEP states:¹²

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or

⁹ See e.g. the Final Office Action at page 3, starting at line 11 through the entire text on page 4.

¹⁰ See the Final Office Action at page 4, lines 16-17.

¹¹ See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, Latest Revision September 2007, at MPEP section 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art [R-6].

¹² See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, Latest Revision September 2007, at MPEP section 2144.03 A. *Determine When It Is Appropriate To Take Official Notice Without Documentary Evidence To Support the Examiner's Conclusion.*

action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). . . .

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. . . .

It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (“[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”).

Thus, a taking of Office Notice according to the MPEP is permissible only in some rare circumstances, and when relying on “common knowledge,” only where the facts asserted are capable of instant and unquestionable demonstration as being well-known. Here, the Final Office Action offers no documentary evidence to support the taking of Official Notice, and the Examiner provides no evidence of record as to how the subject matter included in claims 1-35 and missing from Esposito is capable of “instant and unquestionable demonstration as being well-known.”

Finally, the MPEP states:¹³

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 (“[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.”). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

In support of Applicants pointing out the errors in the Final Office Action's use of Office Notice, attention is directed to the Petition to Make Special filed in the present application based on an International Search Report (hereinafter the "IPER", also included in the Appendix of this response) completed 12 July 2002 and relating to PCT application PCT/US02.04600. The PCT application PCT/US02/04600 states that the PCT application is related to and claims the priority benefit of U.S. Provisional Application No. 60/297,665 filed June 11, 2001 and U.S. Patent Application No. 10/023,583, filed December 14, 2001. U.S. Patent Application 10/023,583 is the present application which is the subject of the Petition to Make Special.

In the IPER, seven documents are referred to as being of particular relevance, including two issued United States Patents and three published United States Patent Applications. As

¹³ See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, Latest Revision September 2007, at MPEP section 2144.03 C. *If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence.*

noted in the Statement in Support of the Petition to Make Special under 37 CFR 1.102(d) filed by Applicants' representative with the Petition to Make Special:¹⁴

"Applicants respectfully submits [sic] that the independent claims 1, 18, and 35 are allowable because claims 1, 18, and 35 are not anticipated under 35 U.S.C. § 102 in view of the references discussed above for at least the reason that each of the references fail to teach or suggest all of the elements included in claims 1, 18, and 35. Applicants further submit that independent claims 1, 18, and 35 are not obvious under 35 U.S.C. § 103 in view of these references discussed above for at least the reason that the references, either alone or in combination, fail to teach or suggest all of the elements included in claims 1, 18, and 35.

For example with respect to claim 1, the references fail to teach, among other things, "responsive to the request, retrieving information concerning a plurality of offerings, wherein the plurality of offerings include a first offering of a first transaction type and a second offering of a second transaction type; integrating information concerning the first and second offerings into a commingled list; and causing the display of the commingled list to the buyer," as recited in claim 1."

Thus, not a single one, or any combination of, the documents cited in the IPER as being relevant to the PCT application discloses, "responsive to the request, retrieving information concerning a plurality of offerings, wherein the plurality of offerings include a first offering of a first transaction type and a second offering of a second transaction type; integrating information concerning the first and second offerings into a commingled list; and causing the display of the commingled list to the buyer," as included in independent claim 1.

It is believed that the present response adequately points out the errors in the Examiner's taking of Official Notice with respect to the rejection of claim 1-35, including stating why the noticed facts are not considered to be common knowledge or well-known in the art. Therefore, Applicants traverse the taking of Official Notice with respect to claims 1-35, including the claimed subject matter for which the Final Office Action expressly states taking Official Notice of, and including the claimed subject matter for which the Final Office Action provides no specific indication of where the claimed subject matter is disclosed or suggested in Esposito.

¹⁴ See Statement in Support of the Petition to Make Special under 37 CFR 1.102(d) filed in the application at page 8.

Balanced against the taking of Official Notice, both expressly and otherwise, is the strong evidence from the documents cited in the IPER that the claimed subject matter included in claims 1-35 is not shown in the prior art, including Esposito.

Pursuant to M.P.E.P. § 2144.03, Applicants traverse the assertion of Official Notice and request that the Examiner cite a reference, cite references, or other evidence in accordance with the rules and the MPEP that disclose the subject matter included in claims 1-35 and missing from Esposito, including the subject matter of claim 1-35 of which the Final Office Action expressly takes Office Notice. If the Examiner cannot cite a reference, references, or other evidence that disclose this subject matter, Applicants respectfully requests that the Examiner provide an affidavit that describes how the missing subject matter is present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicants request withdrawal of the rejection, and reconsideration and allowance of claims 1-35.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have equally addressed every assertion made in the Final Office Action, however, this does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

Serial Number: 10/023,583

Dkt: 2043.052US1

Filing Date: December 14, 2001

Title: METHOD AND SYSTEM AUTOMATICALLY TO SUPPORT MULTIPLE TRANSACTION TYPES, AND TO DISPLAY SELLER-SPECIFIC TRANSACTIONS OF VARIOUS TRANSACTION TYPES IN AN INTEGRATED, COMMINGLED LISTING

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 612-371-2132 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
612-371-2132

Date JANUARY 29/2008

By Robert B. Madden
Robert B. Madden
Reg. No. 57,521

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 29 day of January 2008.

Pete v. Rebuffoni
Name

Pete Rebuffoni
Signature

Receipt is hereby acknowledged for the following in the United States Patent and Trademark Office:

In re Patent Application of: Steve Grove et al

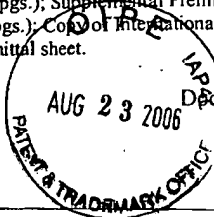
Title: METHOD AND SYSTEM AUTOMATICALLY TO SUPPORT MULTIPLE TRANSACTION TYPES, AND TO DISPLAY SELLER-SPECIFIC TRANSACTIONS OF VARIOUS TRANSACTION TYPES IN AN INTEGRATED, COMMINGLED LISTING

Serial No.: 10/023,583

Filing Date: December 14, 2001

CONTENTS: Petition to Make Special Under 37 CFR 1.102(d), including authorization to charge Deposit Account 19-0743 in the amount of \$130.00 for the Petition fee (2 pgs.); Statement in Support of Petition to Make Special Under 37 CFR 1.102(d) (10 pgs.); Supplemental Preliminary Amendment (16 pgs.); Replacement Drawing Sheets (Figs. 1-15) (15 pgs.); Copy of International Search Report from PCT/US02/04600 (6 pgs.); return postcard and transmittal sheet.

Mailed: August 21, 2006
RBM/pwr



Docket No.: 2043.052US1
Due Date: N/A